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EXAMINER	
HORE, J	
ART UNIT	PAPER NUMBER
153	29

DATE MAILED:

10/13/84

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

~~A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET
TO EXPIRE _____ MONTHS, DAYS FROM THE DATE OF THIS LETTER.~~

The shortened statutory period for response expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the

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petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

The request for reconsideration and 37 CFR 1.131 and 37 CFR 1.132 declarations has been entered and considered but does not overcome the rejection.

For purposes of appeal the status of the claims are as follows:

I.) Claims 59 to 62 and 64 to 69 stand rejected as unpatentable over Japanese patents Nos. 56-2336 and 53-160044 under 35 USC 102(a) for the reasons stated in paragraphs 15 and 19 of the Office actions dated September 28, 1983 and June 14, 1984, respectively. These rejections are being maintained as will be explained hereinbelow.

II.) Claims 63 and 70 drawn to certain organotin stabilizers which are devoid of a halogen radical, in combination with certain carboxylic acid esters of mercapto alcohols stand objected to inasmuch as they are allowable except for their dependency upon rejected claims. Their subject matter is also disclosed by the Japanese patents cited supra, however, applicants' foreign priority applications' disclosures for that invention precede said patents' dates of publication.

III.) Claims 59 to 62 and 64 to 69 also stand rejected as unpatentable under 35 USC 102(a) over the Kugele U.S. Patent No. 4,360,619 issued November 23, 1982. The primary examiner's requirement (paper No. 20 dated June 14, 1984 mailed concomitant with the final rejection of the claims over said Japanese patents) to copy claims for the purpose of interference was upheld in the decision rendered by the Director of Group 150 in a denial of the petition filed July 6, 1981 under 37 CFR 1.181. Hence, the resolution of the question of patentability over the Japanese patents' disclosures wherein a mono organotin mercapto carboxylate halide was used would not render the claims allowable for either that aspect or the alternative organotin halides (devoid of a mercapto carboxylate moiety) which are all within the purview of Kugele's patented invention as indicated by the definition therein of X, X¹ regarding component "A" and Q regarding component "C".

Claims 59 to 62 and 64 to 69 remain rejected over Japanese patents 56-2336 and 55-160044 under 35 USC 102(a).

Applicants' arguments have been carefully considered, applicants' reliance upon In re Tanczyn 146 USPQ 298, 300 (CCPA - 1965) having been particularly noted for the proposition that applicant need only show earlier reduction to practice of a species within his genus, which species need not be identical to one the

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reference discloses. It is applicants' position that their invention, is indicated in their 35 USC 119 priority document (of record in parent application SN 070,503 filed August 28, 1979) has always been directed to the conjoint use of any and all organotin stabilizers, broadly, with the mercapto esters. Using the PTO standard meeting the requirement of a sufficient enabling disclosure under 35 USC 119, the French priority applications (now French patent 2,434,835) reveals in the third paragraph preceding Example 1, that only mono or diorganotin compounds are contemplated rather than any and all organotin compounds as the parent and present applications' original claims were drafted. Hence, applicants' espousals via the proffered declarations that their foreign priority application and their parent application always supported a generic concept is considered erroneously based.

Furthermore, the claims in application SN 70,503 had been rejected on the ground of insufficiency of an enabling disclosure under 35 USC 112 on this very aspect. Moreover, applicants' acquiescence by limiting the claims during the parent applications prosecution to avoid a rejection on the ground of full anticipation under 35 USC 102 over Gough's (U.S. Patent No. 3,928,285) disclosure is probative that applicants did not perceive themselves to be the originators of a generic invention in the use of any and all organotin

compounds in that stabilizer system. Gough's effective date preceded applicants' earliest French priority application's filing date by three years. Since Gough stated (column 1) that organotin compounds had been previously used with other organic thiol (-SH) derivatives whatever "generic" concept applicants perceived in the use of organotin compounds, other than Gough's organotin borates, with thiols which were the mercapto esters which he discloses was clearly already within the prior arts purview long prior to applicants' earliest proof of reduction to practice (the priority French applications filing dates).

Accordingly, applicants' effective filing date for the organotin halides conjoint use being limited to that of the instant application, April 15, 1981, which date proceeds that of the Japanese patents' publication dates, is insufficient to overcome the rejections. The disclosure of the parent application SN 70,503 filed August 28, 1979, now abandoned, is not seen to provide an enabling disclosure sufficient to support applicants' contention that they were in possession of a generic concept prior to the references' publications. Accordingly, contrary to the dicta in In re Tanczyn supra, since applicants are not considered to have been in possession of a generic concept, the reduction to practice of a species within applicants' present genus, which species is not disclosed by the references is not

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deemed sufficient to overcome the references' actual disclosed species, organotin mercapto carboxylate halides, which the claims yet broadly encompass.


Applicants' request in the 37 CFR 1.68 declaration for priority under 35 USC 119 based upon the documents submitted into the parent application's file, is acknowledged.

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GROUP 150 - ART UNIT 153